

**Amendment and Response Under 37 C.F.R. 1.116**

Applicant: John P. Rebhorn et al.

Serial No.: 09/781,581

Filed: February 12, 2001

Docket No.: 5487USA

Title: PORTABLE, STACKED CONTAINER AND METHOD FOR SEPARATELY STORING AND  
DISPENSING TWO CONSUMABLE PRODUCTS, ESPECIALLY CEREAL AND MILK**REMARKS**

This Amendment is responsive to the Final Office Action mailed October 7, 2003. In that Office Action, the Examiner rejected claims 20 and 30 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 1, 4-7, 11, 20, 22-24, and 39-43 were rejected under 35 U.S.C. §102(b) as being anticipated by Bishop, U.S. Patent No. 3,069,043 ("Bishop"). Claims 1-7, 11, 15-20, 22, 23, 25, 28, 29, 31, 33, 39-41, and 43 were rejected under 35 U.S.C. §102(e) as being anticipated by Gerhart et al., U.S. Patent No. 6,528,105 ("Gerhart"). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bishop in view of Siegel et al., U.S. Patent No. 6,209,909 ("Siegel"). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gerhart in view of Ness, U.S. Patent No. 5,743,289 ("Ness"). Claims 9 and 10 were rejected under 35 U.S.C. §102(a) as being unpatentable over Gerhart and further in view of Dickerson, U.S. Patent No. 5,706,980 ("Dickerson"). Claims 21, 24, and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gerhart in view of Siegel. Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gerhart in view of Newarski, U.S. Patent No. 5,496,575 ("Newarski"). Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gerhart in view of Newarski and Siegel. Claims 1-7, 9, 10, 12-19, 22-25, and 28-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dickerson in view of Siegel and Gerhart. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dickerson in view of Siegel and Gerhart and further in view of Ours et al., U.S. Patent No. 6,264,068 ("Ours"). Claims 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dickerson in view of Gerhart and Siegel, and further in view of Newarski.

**Claim Rejections under 35 U.S.C. § 112**

Claims 20 and 39 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner asserts that "a base defining a non-circle perimeter" is not supported by the Applicants' disclosure. Although it is believed that the specification does properly support the cited language, claim 20 has been amended to delete the objected to language and to add a limitation wherein at least a portion of the second compartment side wall defines a non-circle perimeter in the interest of expediting prosecution. The new limitation is fully supported by the specification of the present application on page 13, lines 2-4 and Figures 3A and 3B. In particular, in one exemplary embodiment of the specification, a lower portion of the side wall 62 has a non-circle perimeter since the otherwise circular perimeter is interrupted by the recess 74.

For similar reasons, claim 39 has been amended to remove the objected to language and to add the limitation of the second compartment side wall having a generally circular transverse cross-section except for a portion of the second compartment side wall that inwardly deviates from the otherwise circular transverse cross-section of the second compartment side wall. This language is also supported by the specification as evidence by the same passages and figures cited with respect to claim 20. More specifically, in the exemplary embodiment of Figures 3A and 3B, the second compartment side wall 62 has a generally transverse cross-section, and the recess 74 inwardly deviates from the otherwise circular or transverse cross-section of the second compartment side wall 62. The amendments to claims 20 and 39 are believed to traverse the rejection under 35 U.S.C. §112, first paragraph, and Applicants respectfully request that the rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 102**

Claims 1, 4-7, 11, 20, 22-24, and 39-43 were rejected under 35 U.S.C. §102(b) as being anticipated by Bishop. As recited in previous responses, independent claims 1, 20, 22, and 24 each recite a second, inner compartment including an annular lip and a pour opening formed through the lip. A cover is secured to the lip and sealed to the pour opening. The food package of Bishop includes a cover 20 that extends across the entire perimeter of the inner food container

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5. As illustrated in Figure 4, the cover 20 of Bishop is not secured to the flange 30 in a manner that seals the hole 24 formed through the flange 30. Rather, the positioning of the cover 30 allows liquids or gas to pass between the compartments of the outer container 4 and the inner container 5 through the hole 24 without impediment. Since materials are free to pass through the hole 24, the hole 24 is not "sealed," which means "to close or make secure against access, leakage, or passage" (*Merriam-Webster's Collegiate Dictionary*, 10<sup>th</sup> Ed., page 1049, column 2 (2001)). Therefore, Bishop fails to teach or otherwise suggest, a cover secured to the lip and sealing the pour opening (emphasis added), as recited in independent claims 1, 20, 22, and 24. Therefore, claims 1, 20, 22, and 24 are believed to be allowable over Bishop. Similarly, claims 4-7, 11, 23, and 39-43, which depend from and incorporate the limitations of independent claims 1, 20, and 22, are also believed to be allowable over Bishop.

Claims 1-7, 11, 15-20, 22-23, 25, 28, 29, 31, 33, 39-41, and 43 were rejected under 35 U.S.C. §102(e) as being anticipated by Gerhart. As cited by the Examiner, the lip of Gerhart includes the lip side wall 220, the attaching lip 215, and the eating portion 225. Independent claim 1 has been amended to incorporate the limitation of the now-cancelled dependent claim 42 and, therefore, recites the lip being linear in transverse cross-section. This lip 220/215/225 of Gerhart cited by the Examiner is not linear in transverse cross-section, and in fact, now-cancelled claim 42 was not rejected over Gerhart for presumably this very reason. As such, Gerhart fails to teach or otherwise suggest the limitations of amended, independent claim 1, and Applicants believe independent claim 1 is allowable over Gerhart. In addition, dependent claims 2-7, 11, 39-41, and 43, which incorporate the limitations of amended, independent claim 1, also are believed to be allowable over Gerhart.

Independent claims 15, 20, 22, and 25 have also been amended to further define over the Gerhart rejection. More specifically, amended independent claim 15, recites the lip including a portion radially extending outwardly from the top of the second compartment side wall that also abuts the rim, an exemplary embodiment of which is illustrated in Figure 4 and 6C of the present application. Amended independent claim 20 recites a second compartment side wall including a lower portion having a non-circle perimeter as added to traverse the §112, first paragraph,

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rejection and described above. Amended independent claim 22 recites the first compartment side wall including a spout, an exemplary embodiment of which is illustrated in Figures 2A and 2B and described on page 11, lines 3-7 of the present application. Independent claim 25 has been amended to include a limitation wherein the first compartment side wall and the second compartment side wall collectively have bilateral symmetry. An exemplary embodiment of this arrangement is illustrated in Figure 4 with additional reference to Figures 2B and 3B. Notably, none of the above-described amendments incorporate new matter as each of the amendments is grounded in the figures and the specification of the current application as cited above. Gerhart fails to teach or otherwise suggest any of these limitations. Therefore, amended, independent claims 15, 20, 22, and 25 are believed to be allowable over Gerhart.

Each of dependent claims 16-19, 21, 23, 28, 29, 32, and 33 depends from and incorporates the limitations of one of amended, independent claims 15, 20, 22, and 25, which as described above are not taught or otherwise suggested by any of the cited references. Accordingly, dependent claims 16-19, 21, 23, 28, 29, 32, and 33 are also believed to be allowable over Gerhart.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-7, 10-19, 21, and 22-33 were each rejected under 35 U.S.C. §103(a) over one or more of the following combinations: Bishop in view of Siegel, Gerhart in view of Siegel, Gerhart in view of Newarski and further in view of Siegel, Dickerson in view of Siegel and further in view of Gerhart, Dickerson in view of Gerhart and further in view of Siegel, Dickerson in view of Siegel and Gerhart and further in view of Ours, and/or Dickerson in view of Gerhart and Siegel and further in view of Newarski. As described above, none of the claims are taught or otherwise suggested by Bishop or Gerhart. In addition and as described in the previous Responses by the Applicants, Siegel cannot be viewed as rendering any of the present claims obvious by itself or in conjunction with other references as it fails to qualify as analogous art.

To rely on a reference as a basis for an obviousness rejection of a claimed invention, "the reference must either (1) be in the field of applicant's endeavor or, if not, then (2) be reasonably

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pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker* 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Siegel relates to the decontamination art and, the field of packaging powdered sterilant reagents for use in disinfecting medical instruments (Column 1, Lines 25–29). This is entirely unrelated to the field of the pending application’s containers. Stated otherwise, an inventor devising a new consumable product container would not logically have considered a medical instrument sterilizing package. Clearly, the powdered reagents of the Siegel package are not consumable. Further, the disinfectant packaging of Siegel is not reasonably pertinent to the particular problem associated with the present invention. In particular, the present invention not only addresses the problem of separately containing consumable products, but also facilitating optimal consumption thereof by a consumer through pre-defining pour openings and a fluid passageway.

The Siegel packaging does not dispense the sterilant reagent through an upper aperture 84; instead, the aperture 84 is only provided for filling purposes. The sterilant reagents are released from the Siegel package via knives 14 that pierce the package’s bottom (best shown in Figure 4 of Siegel). Thus, not only does Siegel represent an entirely different field of endeavor, but is in no way pertinent to the problem addressed by the present invention. These facts are highly similar to those presented in *In re Oetiker*, where court held that a reference relating to fasteners for garments was not analogous to the hose clamp invention. Similar, with respect to the present invention, not all packaging or containment problems are analogous. In summary, packaging a sterilant powdered reagent is not analogous to separately containing, and facilitating dispensement thereof, two consumable products. As such, Siegel cannot be used as part of an obviousness rejection for any of the pending claims as it is not analogous prior art. Therefore, each of claims 1-7, 10-19, 21, and 22-33 that were rejected as being obvious over the prior art based at least in part on the Siegel reference are believed to be allowable.

Claims 8-10 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gerhart and Ness, Gerhart and Dickerson, or Gerhart and Newarski. Each of claims 8-10 and 26 depend from and incorporate the limitations of either independent claim 1 or independent claim 25, which as describe above are not taught or otherwise suggested by Gerhart. Neither Ness,

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Dickerson, nor Newarski alter the analysis of independent claim 1 or independent claim 25. Therefore, claims 8-10 and 26 are also believed to be allowable over the cited references.

**CONCLUSION**

In light of the above, Applicants believe independent claims 1, 15, 20, 22, 24, and 25 and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested. No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 500471.

The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this response.

Respectfully submitted,

John P. Rebhorn et al.,

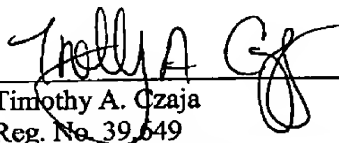
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**CERTIFICATE OF FACSIMILE TRANSMISSION**

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted by facsimile to the U.S. Patent and Trademark Office, Fax No. (703) 872-9311 on this 5th day of December, 2003.

By

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